

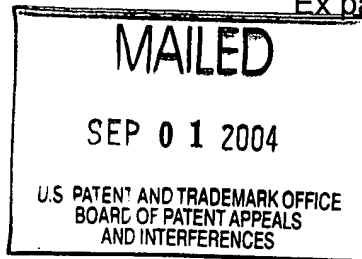
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEUNG-CHEOL HONG and KI-YOUNG JANG



Appeal No. 2004-1044
Application No. 09/942,961

HEARD: August 18, 2004

Before JERRY SMITH, LEVY, and BLANKENSHIP, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

REMAND TO EXAMINER

This is a remand of the appeal under 35 U.S.C. § 134 from the final rejection of claims 11-19, 21-23, 25-33, 35, 36, 38, 42, 43, 46, 55, 56, and 60, in accordance with 37 CFR § 1.196(a), (e). After considering the record before us, we are convinced that the instant appeal is not ready for meaningful review. Accordingly, we hereby remand the application to the examiner to consider the following issues, and to take appropriate action.

BACKGROUND

This application is a reissue of U.S. patent 5,944,830 ("830 patent"), issued on August 31, 1999, from application serial number 08/814,502, filed March 10, 1997. The invention relates to a power management apparatus for a video monitor. Proposed claim 11 is reproduced below.

11. An apparatus, comprising:

a power supply providing power to a heater of a tube in a monitor; and

a switch being disposed between said power supply and the heater, said switch switching off the power provided to the heater when the monitor enters a power-off mode.

The examiner relies on the following reference:

Heineman

5,465,366

Nov. 7, 1995

The examiner further relies on appellants' "Admitted Prior Art." The existence of "Admitted Prior Art" is the principal point of contention in the instant appeal.

Claims 11-19, 21-23, 25-33, 35, 36, 38, 42, 43, 46, 55, 56, and 60 stand rejected under 35 U.S.C. § 103 as being unpatentable over appellants' "Admitted Prior Art" in view of Heineman.

In view of the examiner's indications in the final rejection and the answer, we conclude that claims 1-10 and proposed claims 49-54 are allowed. Proposed claims 20, 24, 34, 37, 39-41, 44, 45, 47, 48, and 57-59 are objected to, but would be allowable if rewritten in independent form.

OPINION

I. The "Admitted Prior Art"

The examiner relies, in the section 103 rejection, on Figure 1 of the '830 patent, and the accompanying description at columns 1, 2, and 4, as "Admitted Prior Art." The '830 patent refers to the power management control apparatus of Figure 1 as an "earlier" apparatus in the "Description of the Related Art" section, and in the detailed description section at column 4.

Appellants' most direct response to the examiner's reliance on the material as "Admitted Prior Art" appears at page 21 of the Brief. "Appellants respectfully submit that Appellants' Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 are not 'prior art' and, furthermore, submit that those portions are not admitted by Appellants to be 'prior art.'"

II. Evidence Not Relied Upon in the Instant Rejection

Appellants filed a certified translation of their foreign priority documents on September 24, 2002 (Paper No. 8). Appellants' translation of patent application number 1996-6135 refers to the "conventional" power management apparatus of Figure 1, rather than the "earlier" apparatus. Appellants' translation of patent application number 1996-4299 speaks of a mode indicating circuit in a "conventional" monitor.

A review of the prosecution in the patent file reveals that claims were rejected under section 103 over "Applicant's Admitted Prior Art" in view of Heineman.

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Appellants noted in remarks in response to the rejection that the applicants only admitted that the power control apparatus of Figure 1 is "an earlier" power management control apparatus. However, appellants amended the claims in response to the rejection, and, consequently, the claims were allowed and the patent issued.

III. "Prior Art"

Judge Giles S. Rich observed that section 103 of Title 35 U.S.C., which makes nonobviousness of the invention a prerequisite to patentability, requires a determination of the differences between the subject matter sought to be patented and "the prior art." However, Title 35 nowhere defines the term "prior art."

Its exact meaning is a somewhat complex question of law which has been the subject of legal papers and whole chapters of books. Basically, the concept of prior art is that which is publicly known, or at least known to someone who has taken steps which do make it known to the public, or known to the inventor against whose application it is being applied.

In re Bergy, 596 F.2d 952, 965 n.7, 201 USPQ 352, 365 n.7 (CCPA 1979), aff'd sub nom. Diamond v. Chakrabarty, 447 U.S. 303, 206 USPQ 193 (1980) (citations omitted).

"The term 'prior art' as used in section 103 refers at least to the statutory material named in 35 U.S.C. § 102. However, section 102 is not the only source of section 103 prior art. Valid prior art may be created by the admissions of the parties." Riverwood Int'l Corp. v. R.A. Jones & Co., Inc., 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed. Cir. 2003) (citations omitted). However, while a reference can become prior art

by admission, that doctrine is inapplicable when the subject matter at issue is the inventor's own work. Id.

Our reviewing court has held that subject matter derived from another (35 U.S.C. § 102(f)), when combined with other prior art, may make a resulting invention unpatentable under 35 U.S.C. § § 102(f) and 103. OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1403-04, 43 USPQ2d 1641, 1646 (Fed. Cir. 1997).

Subsection (c) of section 103 effectively disqualifies information or activity under subsections (e), (f), and (g) of section 102 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See 35 U.S.C. § 103(c) (1999). However, the section 103(c) exclusion with respect to subsection (e) of section 102 only affects patents filed on or after the November 29, 1999 effective date. Riverwood Int'l Corp. at 1355 n.2, 66 USPQ2d at 1338 n.2. Since the '830 patent application was filed on March 10, 1997, section 102(e) publications are not excluded under 35 U.S.C. § 103(c).

IV. 37 CFR § 1.105

The object and policy of the patent law require issuance of valid patents. Blacklight Power, Inc. v. Rogan, 295 F.3d 1269, 1273, 63 USPQ2d 1534, 1537 (Fed. Cir. 2002). If, for example, appellants invented the Figure 1 power management apparatus described in the '830 patent, appellants could have provided a clear

statement that appellants are the inventors of the subject matter.¹ Appellants, instead, alleged a legal conclusion, in a complex area of law, and submitted various theories as to why the subject matter might not necessarily represent "prior art." Appellants have not provided the factual basis upon which the legal conclusion rests (e.g., by identifying the origin of the Figure 1 power management apparatus), and then submitting a reason why the law does not allow the information in the '830 patent to be considered in a section 103 analysis.

Upon return of this application to the examiner's jurisdiction, the examiner may require the submission of information pursuant to 37 CFR § 1.105, under the guidelines set forth in the Manual of Patent Examining Procedure (MPEP) § 704 (8th ed., Rev. 2, May 2004). MPEP § 704.11(b) notes that a requirement may be made at any time once the necessity for it is recognized and should be made at the earliest opportunity after the necessity is recognized. The MPEP also notes that, although optimally made prior to the first action on the merits, factors to be considered in a requirement include:

(F) Whether the specification's background of the invention describes information as being known or conventional, which may be considered as an admission of prior art, but such information is unfamiliar to [the] examiner and cannot be found within the application file or from the examiner's search, and further details of the information would be relevant to the question of patentability.

MPEP § 704.11(b) at 700-9.

¹ The rejection did not rely on the admissions in the file with respect to what was "conventional."

V. Heineman

Proposed claim 11 recites "said switch switching off the power provided to the heater when the monitor enters a power-off mode." An initial reading of the claim suggests that some unspecified apparatus causes the monitor to enter a power-off mode. However, we do not find any description in the '830 patent of anything turning off power to the monitor, other than switching circuit 240 (Fig. 2), at the behest of microcomputer 250, in the operation described in column 5 of the patent. Nor do we find any description of any other apparatus causing the monitor to enter a power-off mode. When questioned on the point at the oral hearing, in regard to the apparatus shown in Figure 2, appellants' counsel submitted that the figure need not show what is "conventional," in accordance with 37 CFR § 1.83(a).

The '830 patent, at column 1, lines 21 through 35, describes how a monitor may enter a power-off mode according to the DPMS system established by VESA, when HSYNC and VSYNC signals are not supplied to the monitor. The patent elsewhere refers to a "standard" mode established by VESA (e.g., col. 4, ll. 54-60). Appellants indicate in the Brief (at 21) that the VESA standards are not "prior art," although the standards relate to, apparently, "conventional" (i.e., known to the artisan) subject matter.

Regardless of whether the standards are admitted to be prior art, prior art U.S. patent references (at least Hwang, 5,736,873 and Kung, 5,555,032) that were cited during prosecution of the '830 patent provide a fuller description of the DPMS VESA

standards. As described by Kung, column 3, line 38 through column 4, line 25, a monitor is to enter an "off" state (i.e., the lowest power state) when horizontal and vertical sync signals are not present on the input. Since switching circuit 240 (Fig. 2) in the '830 patent powers off the heater to the monitor (thereby reducing the electrical power consumed by the monitor to below five watts; col. 1, ll. 33-35), when microcomputer 250 senses that the HSYNC and VSYNC signals are not supplied from the computer, instant claim 11 may be read as the switch switching off the power provided to the heater to effect the monitor's power-off mode. As described in appellants' specification, the lack of HSYNC and VSYNC signals indicate that the monitor is to enter power-off mode. The monitor enters power-off mode, however, by operation of switching circuit 240.

Heineman describes a power control module 20 (Fig. 2) that includes a power switch 40 which turns off power to monitor 12. We do not see how a claim of the scope of instant claim 11 is not anticipated (35 U.S.C. § 102) by the reference.

Claim 11 recites switching off the power "provided to the heater." Monitor 12 of Heineman contains a heater. The monitor shown in Figures 1 and 4, as indicated by its shape and other characteristics, is a cathode-ray tube (CRT) monitor. Compare, for example, the CRT monitor of Figure 1 shown in Shahbazi, 5,481,732, also cited in the '830 patent. We are placing a reference in the record to show that a CRT monitor

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necessarily includes a heater.² When a reference is silent about an asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Needless to say -- although, in this case, we will -- when the power to monitor 12 in Heineman is switched off, the power provided to the heater is also switched off.

² McGraw-Hill Encyclopedia of Science & Technology 7th Ed., Vol. 3, "Cathode-ray tube," pp. 304-312 (1992). A copy of the reference and a copy of form PTO 892 (Notice of References Cited) should mail as an attachment to this opinion.

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CONCLUSION

This application, by virtue of its "special" status, requires an immediate action.
See MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED



JERRY SMITH
Administrative Patent Judge



STUART S. LEVY
Administrative Patent Judge



HOWARD B. BLANKENSHIP
Administrative Patent Judge

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